

Application No. 09/992,861
Amendment dated January 20, 2004
Final Response to Office Action dated October 20, 2003

REMARKS

Claims 1, 3-8, and 10-20 are pending. Applicants gratefully acknowledge withdrawal of the prior rejections under 35 U.S.C. § 112 and the art rejection over the Pearson reference under 35 U.S.C. § 103. Applicants further ask for reconsideration and allowance of the remaining claims in view of the following remarks.

Claim Rejections - 35 U.S.C. § 112

Claims 12-15 stand rejected as indefinite in that "the tape" in the last line of claim 12 lacks antecedent basis. Claim 12 has been amended to recite "the material" in place of "the tape" in the last line of claim 12. Antecedent basis for "the material" appears in the preamble. Support for the amendment is found at page 2, line 22 of the description. No new matter has been added. Applicants ask that this ground of rejecting claims 12-15 be withdrawn.

Claim Rejections - 35 U.S.C. §§ 102, 103

Claims 1, 3-8, 10, 12-14, and 16-20 remain rejected as anticipated by U.S. 2,584,065 (Taylor). In addition, claims 7 and 8 are rejected as obvious over Taylor alone, and claims 11 and 15 are rejected as obvious over Taylor in view of U.S. 3,895,059 (Link). Applicants respectfully traverse these rejections.

Applicants maintain that Taylor does not disclose or suggest the claimed depression for placement of a finger on the top of the cover piece. This depression serves to enable the user to

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comfortably grasp Applicants' device and to dispense material using one hand. See description at page 10, lines 5-8 and 17-20.

The Examiner has cited a depression on the top cover of the Taylor device where a user might place a finger. The Examiner further grants that placement of a finger in this position on the Taylor device would result in contact with the feed roller, but answers that such contact is not excluded by Applicants' claims.

But such contact need not be excluded by the claims, because the depression on the Taylor device does not satisfy the structural or functional features of Applicants' depression as claimed. As pointed out above, Applicants' depression aids the user in gripping the device and dispensing material from it with one hand. A user of Taylor's device, placing a finger in its depression, contacting the tape rolling over the feed roller, would necessarily stop the advance of tape from the supply roll, rendering the device inoperative. Thus Taylor's "depression" is not the same as Applicants', and Taylor cannot anticipate Applicants' claims.

Moreover, one of skill could not modify Taylor properly to omit this defect, because it would render the Taylor device inoperative in a different way. The purpose of the "depression" having the opening (32) is to enable a user to access the feed roller with a thumb to advance a new supply of tape out of the dispensing end after the previous piece has been discharged and cut. Taylor, col. 2, line 66 to col. 3, line 7. Access to the feed roller for this purpose is necessary because the Taylor device severs the discharged tape inside the pocket of the cover, where the cutting edge is located. Taylor, col. 3, lines 4-6.

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Thus, unless the user advances the tape with the feed roller, the cut tape end cannot be reached by the user.

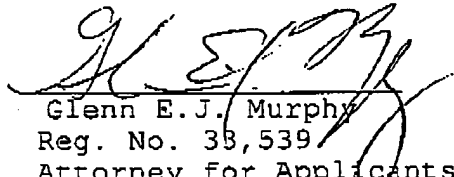
Removing access to the feed roller by covering or closing the opening (32) (thus avoiding the inoperability created by grasping the device in this depression) would require the user to open the Taylor housing to advance the tape each time a piece was dispensed and cut. But such a modification directly contradicts an explicit object of Taylor's invention - to provide for one-handed feeding, applying, and cutting of tape. Taylor, col.1, lines 6-10. Thus Taylor cannot be modified to reach Applicants' claims without rendering it unsuitable for its intended purpose. M.P.E.P. § 2143.01. For these reasons, Applicants' claims cannot be anticipated or obvious over Taylor.

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CONCLUSION

Applicants respectfully request reconsideration and allowance of the claims in view of the amendments and remarks above. Should any fees be due that have not been accounted for, the Commissioner is authorized to charge them to Deposit Account No. 01-1250.

Respectfully yours,


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